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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/706,136	08/30/96	VANDENBELT R	HW-106A

EXAMINER	
CHANG, V	
ART UNIT	**PAPER NUMBER**
2743	

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DATE MAILED: 06/12/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/706,136	Applicant(s) Anderson et al
	Examiner Vivian Chang	Group Art Unit 2743

☒ Responsive to communication(s) filed on *Mar 27, 1998* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-12 and 14-18* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-12 and 14-18* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-12 and 14-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Newly amended independent claims 1, 5, 10, 14-15 and 17 recite "--that is capable of continual, perpetual, uninterrupted replay of sounds selected for individual replay" which was never disclosed before and therefore they are considered as new matters.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loudermilk (US 5,504,836) in view of Grewe et al (US 5,625,608).

Consider claim 1. Loudermilk teaches a digital sound entertaining system having built-in prerecorded sounds selectable for individual replay; see fig. 2. Loudermilk does not show the system has a collectable sound card. However, Grewe teaches that it is a well known practice to make a computer system which can access with external memory chips (see 16) so that external data could have been provided to the user as well as internal data. Therefore it would have been obvious for one skilled in the art at the time the invention was made to modify the device of Loudermilk with the teaching of Grewe so that more choices of audio information could have been provided to users . It would have been obvious that the music chip of the device of Loudermilk as modified by Grewe could have been replaced with a collectable sound card since they are all well known alternative memeory devices which could have been enabled the device work equivalently well.

Loudermilk does not teach that the audio signals are capable of continual, perpetual and uninterrupted replay (note: assuming in case that limitation is not new matter). However, according to the examiner's best understanding, the reason that the system is capable of continual, perpetual and uninterrupted replay is because the audio signals are stored in a loop format. The examiner takes official notice that audio signals stored in a loop format or a sound bite format are

well known in the art and therefore would have been obvious since they are all known alternative formats that audio signals could have been stored in. And therefore, the system of Loudermilk as modified would have the capability of such claimed continual, perpetual and uninterrupted replay.

Consider claim 2. Loudermilk teaches the claimed limitation; see fig. 2.

Consider claim 3. Loudermilk teaches the system has a plurality of switches. Loudermilk does not teach a sound card selector switch for reassigning the switches between the built-in and sound card sounds. However, it would have been obvious to include such a switch since the computer has to be notified whether the selector switches are going select information from the internal memory or the external memory.

Consider claim 4. It would have been obvious that an indicia would have been included to associate with the reassigning switch so that users could have been visually informed its existence.

Consider claims 5-6, 10 and 14-18. Note the discussion of claims 1-4, the device of Loudermilk as modified teaches the claimed limitations.

Consider claim 7. Regarding the specific location through which the port is provided, it would have been obvious since it would have been determined based on user's preference, e.g., how convenient to load the memory card in.

Consider claims 8-9 and 11-12. The examiner takes official notice that audio signals stored in a loop format or a sound bite format are well known in the art and therefore would have been obvious since they are all known alternative formats that audio signals could have been stored in.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Barker et al (US 4,538,188 is cited as showing that loop formats is well known in the art.

Morris et al (US 5,390,239) is cited as showing that sound bite format is well known in the art.

5. Applicant's arguments with respect to claims 1-12 and 14-18 have been considered but are moot in view of the new ground(s) of rejection.

The claims are rejected under new matter for the reasons as set forth above.

Furthermore, in case that added limitation is not new matter, the claims are still not patentably distinct since the examiner realized that limitation is resulted from the format the data are stored (i.e., loop format or sound bite format), which are well known data formats.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chang whose telephone number is (703) 308-6739.

Vivian Chang

PATENT EXAMINER

GROUP 2700

VC

June 2, 1998